

Applicants: C. Dominique Toran-Allerand
Serial No.: 10/665,847
Filed: September 19, 2003
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In the Office Action, the Examiner restricted pending claims 1-41 to one of the following allegedly distinct inventions under 35 U.S.C. §121 as follows:

- I. Claims 1 and 2, drawn to an isolated estrogen receptor, classified in class 530, subclass 350;
- II. Claims 3 and 4, drawn to a composition of matter comprising a lipid membrane, classified in class 435, subclass 7.2;
- III. Claims 5-9, drawn to a method for determining the binding and the affinity of an agent to the receptor, classified in class 435, subclass 7.1;
- IV. Claims 10-13, drawn to a method for determining an agonist or antagonist of the receptor, classified in class 435, subclass 7.1;
- V. Claims 14-16, drawn to a method for activating the MAP kinase pathway of a cell with 17 α -estradiol, classified in class 435, subclass 7.21;
- VI. Claims 17-22, drawn to a method for treating or delaying onset of an neurodegenerative disorder by administering 17 α -estradiol, classified in class 514, subclass 182;
- VII. Claims 23-27, drawn to a method for treating a neurodevelopmental disorder by administering 17 α -estradiol, classified in class 514, subclass 182;

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- VIII. Claims 28-33, drawn to a method for treating a sexually dimorphic childhood disorder of cognition by administering 17 α -estradiol, classified in class 514, subclass 182;
- IX. Claims 34-36, drawn to a method for treating a uterine disorder by administering 17 α -estradiol, classified in class 514, subclass 182;
- X. Claims 37-39, drawn to a method for treating a pulmonary disorder by administering 17 α -estradiol, classified in class 514, subclass 182; and
- XI. Claims 40 and 41, drawn to a composition of 17 α -estradiol, and an article comprising same, classified in class 514, subclass 182.

In response, applicants hereby elect Group IV, claims 10-13, drawn to a method for determining an agonist or antagonist of the receptor, with traverse for prosecution at this time.

Applicants, however, respectfully request that the Examiner reconsider and withdraw the restriction requirement.

Under 35 U.S.C. §121, restriction may be required if two or more independent and distinct inventions are claimed in one application. The inventions in groups I-XI are not independent. Under M.P.E.P. §802.01, "independent" means there is no disclosed relationship between the subject matter claimed. The inventions in groups I-XI are drawn to a particular type of isolated mammalian cell-surface receptor and compositions comprising the same and their methods of

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use. Applicants therefore maintain that Groups I-XI are not independent and restriction is not proper.

Furthermore, under M.P.E.P. §803, the Examiner must examine the application on the merits if examination can be made without serious burden, even if the application would include claims to distinct or independent inventions. That is, there are two criteria for a proper requirement for restriction: (1) the invention must be independent and distinct, and (2) there must be a serious burden on the Examiner if restriction were not required.

Applicants respectfully submit that there would not be a serious burden on the Examiner if restriction were not required, because a search of the prior art relevant to the claims of Groups I-III and V-XI would provide the relevant prior art for Group IV, and vice versa. Since there is no burden on the Examiner to examine groups I-XI together in the same application, the Examiner must examine the entire application on the merits.

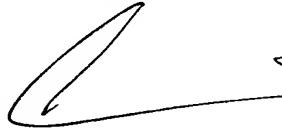
In view of the foregoing, applicants maintain that restriction is not proper under 35 U.S.C. §121, and respectfully request that the Examiner reconsider and withdraw the requirement for restriction.

If a telephone interview would be of assistance in advancing the prosecution of the subject application, applicants' undersigned attorneys invite the Examiner to telephone them at the number provided below.

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No fee, other than the \$795.00 fee for a four-month extension of time, is deemed necessary in connection with the filing of this Communication. However, if any additional fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:

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12/7/06

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